

AMENDMENT

In the Drawings

Please add the replacement drawing sheet (replacing sheet 3), which includes amended Figure 4A (formerly Figure 4). Please add the new drawing sheet, which includes new Figures 4B and 4C. The subject matter of new Figures 4B and 4C is supported by the specification as originally filed (see paragraph [1036]).

REMARKS

Entry of the foregoing amendments and reconsideration of this application are respectfully requested in view of the following remarks.

Objections Under 37 C.F.R. § 1.83(a)

The drawings are objected to under 37 C.F.R. § 1.83(a) because they do show every feature of the invention specified in the claims. The Applicants have amended the Figures to include amended Figure 4A (formerly Figure 4) and new Figures 4B and 4C. The subject matter of new Figures 4B and 4C is supported by paragraph [1036] of the specification as originally filed. The Applicants have amended the specification to include a replacement paragraph [1009] and two new paragraphs in the Brief Description of the Drawings to include the amended Figure 4A and new Figures 4B and 4C. The Applicants have also amended the specification to include a replacement paragraph [1036] in the Detailed Description to include a reference to the amended Figure 4A and new Figures 4B and 4C. Accordingly, the Applicants request that the objection to the drawings be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 1-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,332,223 to LeGette et al. ("*LeGette*") in view of U.S. Patent No. 6,065,157 to Felman ("*Felman*"). *LeGette* is directed to an ear warmer that includes a set of membranes and a frame. *Felman* is directed to an ear warmer that is supported by a user's eye glasses. This rejection is traversed for the reasons set forth below.

No motivation or teaching exists to combine the cited references

If the proposed combination would render the cited reference as modified unsatisfactory for its intended purpose, then no suggestion or motivation exists to make the proposed modification, and the obviousness rejection is improper. MPEP § 2143.01. The intended purpose of *Felman* is to provide a comfortable ear warmer that “do[es] not press against the wearer’s ears.” Column 1, Lines 24-25. More particularly, *Felman* is directed to an ear warmer that uses the temples (referred to as “templates”) of eye glasses (18, 20) to hold the ear covers in place without “bearing against the sides of the ear.” Column 2, Lines 52-53; Column 3, Lines 3-5. Conversely, *LeGette* discloses an ear warmer that is held in place on the user’s head without being supported by eye glasses. Rather, the ear warmer disclosed in *LeGette* is held in place by a frame configured to press against the user’s ears. Column 4, Lines 5-22; *see also* FIG. 1 of U.S. Patent No. 5,835,609, which is incorporated into *LeGette* by reference. As such, the proposed modification of *Felman* to include a frame of the type disclosed in *LeGette* is improper because it would destroy the intended functionality of the ear warmer disclosed in *Felman*.

Furthermore, if the proposed combination of cited references would change the principle of operation of the references being modified, then the combination is improper. MPEP § 2143.01. Here, the proposed modification of *Felman* to include a frame impermissibly changes the principle of operation disclosed in *Felman*. *Felman* discloses an ear warmer that uses the temples of eye glasses (18, 20) in cooperation with a pair of straps (26, 28) to hold the ear covers in place. Column 2, Lines 52-57. The proposed addition of a frame is entirely unneeded and duplicative of the support provided by the eye glasses, and therefore, impermissibly changes the principle of operation of the ear warmer disclosed in *Felman*. Accordingly, the Applicants request that for at least these reasons, the rejection of claims 1-33 be withdrawn.

The cited references fail to disclose all of the claim limitations

If the cited references fail to teach or suggest all of the claim limitations, then the obviousness rejection is improper. MPEP § 2143.03. Here, the cited references fail to disclose or suggest all of the claim limitations.

More specifically, unlike independent claim 22, *Felman* fails to disclose or suggest an ear warmer having a membrane having a first configuration in which “a portion of the membrane [is] disposed adjacent the inner member of the cover” and a second configuration in which “the portion of the membrane [is] disposed adjacent the outer member of the cover.” Also, unlike independent claim 27, *Felman* fails to disclose or suggest an ear warmer having a membrane having a first configuration in which “a portion of the membrane [is] disposed adjacent the inner side of the cover” and a second configuration in which “the portion of the membrane [is] disposed adjacent the outer side of the cover.” Also, unlike independent claim 30, *Felman* fails to disclose or suggest an ear warmer having a membrane that is “movable from a first position on one side of the cover to a second position on another side of the cover.”

In the Official Action, the Examiner takes the position that the configuration of *Felman* “allows for the membrane to be manipulated in a deployed configuration and a retracted configuration, with the movable portion of the membrane disposed adjacent the inner side when the membrane is in its deployed configuration and at least a portion of the movable portion of the membrane disposed adjacent the outer member when the membrane is in its retracted configuration.” *Felman*, however, fails to disclose or suggest a retracted position in which a portion the rear flap portions (34, 36) is disposed adjacent to an outer portion of the side panels (30, 32). Moreover, because the rear flap portions are attached via the straps (26, 28) to assist in holding the ear covers in place, *Felman* teaches away from such a retracted configuration.

Additionally, the mere fact that a reference can be modified does not render such a modification as obvious unless the references also suggest the desirability of such modification. MPEP § 2143.01. Here, *Felman* contains no suggestion that configuring the rear flap portions (34, 36) to be disposed adjacent the outer portion of the side panels (30, 32) is desirable. The Applicants therefore request that for at least these reasons, the rejection of independent claims 22, 27 and 30, and their respective dependent claims be withdrawn.

CONCLUSION

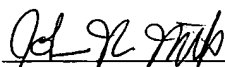
All of the stated grounds of objection and rejection have been properly traversed or rendered moot. The Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding objections and rejections. Applicants believe that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

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